

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AUDREY CONTENTE,
BRUCE F. ROSS
and
RICHARD C. POTTER

Appeal No. 97-2555
Application No. 08/215,062¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge,
PATE and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4 to 16, 19 to 23, 82, 86, 87, 91 to 93 and 97, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

¹ Application for patent filed March 21, 1994.

BACKGROUND

The appellants' invention relates to a vaginal discharge collection device. An understanding of the invention can be derived from a reading of exemplary claims 1, 4 and 86 (the independent claims on appeal), which appear in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Davis et al. (Davis)	3,983,874	Oct. 5, 1976
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Claims 1, 4 to 16 and 19 to 23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1, 4, 9, 10, 13, 14, 19, 23, 82, 86, 87, 91 and 97 stand rejected under 35 U.S.C. § 102(a, b and e) as being anticipated by Davis.

Claims 5 to 8, 11, 12, 15, 16, 20 to 22, 92 and 93 stand rejected under 35 U.S.C. § 103 as being unpatentable over Davis.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 7, mailed July 7, 1995) and the examiner's answer (Paper No. 15, mailed June 25, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 14, filed March 7, 1996) and reply brief (Paper No. 16, filed August 22, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness issue

We do not sustain the rejection of claims 1, 4 to 16 and 19 to 23 under 35 U.S.C. § 112, second paragraph.

The examiner's complete statement (final rejection, p. 3) of the reasons for this rejection is

[t]he following are examples of lack of clarity problems that occur through out these claims. It is left to Applicant and their Counsel to identify and correct all those not explicitly made example of below.

Claim 1 is indefinite because the term " the height " and " is indefinite as to what plane of reference is intended to be referred to determine the height.

The initial burden is on the examiner to identify the specific portions of the claims which fail to particularly point out and distinctly claim the subject matter which the appellants regard as the invention. This the examiner has done only with respect to independent claim 1. Accordingly, the examiner's rejection of independent claim 4, and claims 5 to 16 and 19 to 23 dependent thereon, under 35 U.S.C. § 112, second paragraph, is reversed since the examiner has not specified any indefiniteness with respect to these claims.

We agree with the appellants (brief, p. 7) that the term "the height" in claim 1 is definite. The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and

of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. In this case, the appellants specification (pp. 30-38) and Figure 31 clearly define which dimension of the rim is "the height" and which dimension of the rim is "the thickness." Thus, the meaning of the term "the height" in claim 1 would be understood by one skilled in the art. Accordingly, the examiner's rejection of claim 1 under 35 U.S.C. § 112, second paragraph, is reversed.

The prior art issues

Claims 1, 4 to 16 and 19 to 23

We do not sustain the rejection of claims 1, 4, 9, 10, 13, 14, 19 and 23 under 35 U.S.C. § 102(a, b and e). Likewise, we do not sustain the rejection of claims 5 to 8, 11, 12, 15, 16 and 20 to 22 under 35 U.S.C. § 103.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what

subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claims 1, 4 to 16 and 19 to 23 each recite the limitation that the elastomeric rim has a height to thickness ratio of approximately two and one-half.

The examiner believes that this limitation "reads on" the lip 21 of Davis as shown in Figure 3 (answer, pp. 5-6). The appellants disagree (brief, pp. 8-11).

Davis is silent as to both the height and thickness of his lip 21. While lip 21 is shown in Figure 3, the patent drawings are not drawn to scale; thus, Figure 3 does not disclose the height and thickness of lip 21. Since neither the height or thickness of lip 21 is disclosed, Davis cannot disclose, either

expressly or inherently, the claimed ratio of height to thickness of approximately two and one-half.

In our view, all the limitations of claims 1, 4 to 16 and 19 to 23 are not taught or suggested by Davis. Accordingly, the examiner's rejections thereof are reversed.

Claims 82 and 86

We sustain the rejection of claims 82 and 86 under 35 U.S.C. § 102(a, b and e).

Independent claim 86 recites a vaginal discharge collector, comprising, inter alia, a body means for providing a collection space and an annular rim means for providing resilient outward holding force sufficient for holding the collector in position during use. The body means includes an annular opening² and a top. The annular rim means is affixed to the body means proximate the top of the body means and is concentric with the opening of the body means. Dependent claim 82 recites that the

² We note that the openings shown in the appellants' drawings are circularly shaped, not annularly shaped.

rim means is composed of material that includes a shape memory material.

Davis discloses a catamenial device that presents a reservoir for the uterine discharge and with an expendable tampon retained therein (column 1, lines 63-66). As shown in Figures 1 and 3, the catamenial device includes a diaphragm D stabilized in position by its flexible rim R. The rim R is reinforced by spring coil 10 weakened at diametrically opposite portions (not shown) so as to facilitate collapse for insertion into position in the vagina. The rim R carries a cover C provided with an inturned lip 21 to define an opening 20. The diaphragm D and the cover C are formed of supple and pliant elastic material within which a tampon T is inserted. In addition, Davis teaches that a spermicidal preparation can be applied to the cover C.

Claims 82 and 86 are readable on Davis. Claim 86 reads on Davis as follows: A vaginal discharge collector (Davis' catamenial device) comprising: a body means (Davis' diaphragm D) for providing a collection space and having an annular opening for the passage of discharge into said space, said body means having a top; and an annular rim means (Davis' rim R) for providing resilient outward holding force sufficient for holding the collector in position during use, said rim means being

affixed to said body means proximate the top of said body means, said rim means being concentric with said opening. Claim 82 reads on Davis as follows: said rim means (Davis' rim R) is composed of material that includes a shape memory material (Davis' spring coil 10 or the material forming protective rim 13).

The argument advanced by the appellants (brief, pp. 15-16) does not convince us that these claims are not anticipated by Davis for the following reasons. First, it is our opinion that Davis' rim R is equivalent to the corresponding rims described in the present specification especially since the rims could contain a coil spring as disclosed in the appellants' Figure 24. Second, it is our view that Davis' rim R does provide a resilient outward holding force sufficient for holding the device in position during use since Davis teaches (column 2, lines 55-58) that the diaphragm D is stabilized in position by the flexible rim R.

In our view, all the limitations of claims 82 and 86 are taught by Davis. Accordingly, the examiner's rejections thereof are affirmed.

Claims 87, 91 to 93 and 97

We do not sustain the rejection of claims 87, 91 and 97 under 35 U.S.C. § 102(a, b and e). Likewise, we do not sustain the rejection of claims 92 and 93 under 35 U.S.C. § 103.

Claim 87 and its dependent claims (i.e., claims 91 to 93 and 97) require that at least one of the body means and rim means includes a substance released during use of the collector.

The examiner believes that this limitation "reads on" the spermicidal preparation that can be applied to Davis' cover C (answer, p. 8).

We agree with the appellants (brief, p. 17) that the spermicidal preparation of Davis is not "released" during use. Accordingly, this limitation does not "read on" the spermicidal preparation applied to Davis' cover C. Thus, in our view, all the limitations of claims 87, 91 to 93 and 97 are not taught or suggested by Davis. Accordingly, the examiner's rejections thereof are reversed.

CONCLUSION

To summarize, (1) the decision of the examiner to reject claims 1, 4 to 16 and 19 to 23 under 35 U.S.C. § 112, second paragraph, is reversed; (2) the decision of the examiner to reject claims 82 and 86 under 35 U.S.C. § 102(a, b and e) is affirmed; (3) the decision of the examiner to reject claims 1, 4, 9, 10, 13, 14, 19, 23, 87, 91 and 97 under 35 U.S.C. § 102(a, b and e) is reversed; and (4) the decision of the examiner to reject claims 5 to 8, 11, 12, 15, 16, 20 to 22, 92 and 93 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
WILLIAM F. PATE, III)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 97-2555 - JUDGE NASE
APPLICATION NO. 08/215,062

APJ NASE

APJ McCANDLISH

APJ PATE

DECISION: **AFFIRMED-IN-PART**

Prepared By: Delores A. Lowe

DRAFT TYPED: 12 May 98

FINAL TYPED: